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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,318	11/16/2000	Mary Swaab	500991	6476

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EXAMINER
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STAIKOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 08/27/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,318

Applicant(s)

SWAAB, MARY

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-29 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 16, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 8-9 are objected to because of the following informalities: in claim 8, line 6, after "softened", --at least one lipstick base-- should be inserted. Claim 9 is objected to as a dependent claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 recites the limitation "the mixed lipstick pigments" in line 9. There is insufficient antecedent basis for this limitation in the claim. Claims 27-29 are rejected as dependent claims.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 7-18 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins *et al.* (US Patent No. 5,780,018).

Regarding claims 7, 14 and 26, Collins *et al.* ('018) teach the claimed process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of color pellets (pigments) and a plurality of doses of oil blend (bases), mixing said color pellets with said oil blend, heating said mixture, pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick. Further regarding claim 14, it should be noted that recitation of the intended use of the claimed process of making a customized lipcoloring product must result in a structural difference between the claimed process and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure, as taught by Collins *et al.* ('018) is capable of performing the intended use, as claimed, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art and as such whether the process is

performed at a retail establishment or at home does not appear to provide patentability to the method upon which patentability must be determined.

In regard to claim 8, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35).

Specifically regarding claim 9, Collins *et al.* ('018) teach using a plurality of different color pellets (pigments) in order to obtain a customized color shade (see col. 6, lines 12-22).

Regarding claims 10 and 18 Collins *et al.* ('018) teach a semi-solid paste as a color pellet. Since, Collins *et al.* ('018) specifically teach mixing of said color pellets with an oil blend, it is submitted that a semi-solid paste with an oil blend is mixed on a blending sheet since a paste is a semi-solid substance that is spread during mixing.

In regard to claim 11 and 15-16, Collins *et al.* ('018) teach heating using a microwave oven (see col. 6, lines 27-35).

Specifically regarding claims 12-13, 17 and 27-28, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer. Since the customer receives the molded lipstick it is submitted that said customer waits at the retail establishment while said customized lipstick is being molded.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 19, 22-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins *et al.* ('018) in view of Lombardi *et al.* (US Patent No. 6,177,093 B1).

Collins *et al.* ('018) teach the basic claimed process as described above.

Regarding claim 1, Collins *et al.* ('018) do not teach applying the mixture to the customer for evaluation. Lombardi *et al.* ('093) teach a process for customizing a lipstick including, providing a customer request, heating a plurality of colored pellet material to obtain a customized color according to said request, transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the color based upon customer input (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach applying the mixture to the lips of the customer for evaluation. Therefore, it would have been obvious for one of ordinary skill in the art to have applied the mixture to the lips of the customer for evaluation as taught by Lombardi *et al.* ('093) in the process of Collins *et al.* ('018) because, Lombardi *et al.* ('093) specifically teach modifying the color of a customized lipstick based upon customer input and also because, both references teach similar end-products and solve similar problems of providing a customized color sale to a customer at the point-of-sale.

In regard to claims 2 and 3, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35).

Specifically regarding claims 4 and 6, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer. Since the customer receives the molded lipstick it is submitted that said customer waits at the retail establishment while said customized lipstick is being molded.

Regarding claim 5 and 20, Collins *et al.* ('018) teach a semi-solid paste as a color pellet. Since, Collins *et al.* ('018) specifically teach mixing of said color pellets with an oil blend, it is submitted that a semi-solid paste with an oil blend is mixed on a blending sheet since a paste is a semi-solid substance that is spread during mixing.

In regard to claims 19 and 29, Collins *et al.* ('018) do not teach repeating the selecting, measuring and mixing steps in order to achieve the desired shade. Lombardi *et al.*, ('093) teach a process for customizing a lipstick including, providing a customer request (selecting), measuring, mixing and heating a plurality of colored pellet material to obtain a customized color according to said request, transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the final color based upon customer input during the manufacturing process (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach repeating the steps of selecting, measuring and mixing as described above. Therefore, it would have been obvious for

one of ordinary skill in the art to have modified the final color based upon customer input during the manufacturing process (repeating the steps of selecting, measuring and mixing) as taught by Lombardi *et al.* ('093) in the process of Collins *et al.* ('018) because, Lombardi *et al.* ('093) specifically teach modifying the color of a customized lipstick based upon customer input and also because, both references teach similar end-products and solve similar problems of providing a customized color sale to a customer at the point-of-sale.

Specifically regarding claim 22, Collins *et al.* ('018) teach adding moisturizers, an anti-oxidant and a perfume to the oil blend (base) and to the color pellet (see col. 3, lines 7-28).

Regarding claim 23, Collins *et al.* ('018) teach heating using a microwave oven (see col. 6, lines 27-35).

In regard to claim 24, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer.

Specifically regarding claim 25, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35).

***Allowable Subject Matter***

8. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



***Conclusion***

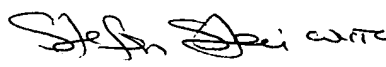
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached at (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD

  
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August 25, 2002